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EXAMINER

LETT, THOMAS J

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/776,057
Filing Date: February 02, 2001
Appellant(s): SESEK, ROBERT

Steven R. Ormiston
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 16 August 2007 appealing from the Office action mailed 12 March 2007. For the above reasons, it is believed that the rejections should be sustained.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

5,629,981	Nerlikar	5-1997
6,952,780 B2	Olsen et al	10-2005

Drabble, Andrew WO 00/62474 Method and Means for Effecting Secure Communication, 10-2000.

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 21-23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nerlikar (USPN 5,629,981 A) in view of Olsen (USPN 6,952,780 B2).

Regarding claim 21, Nerlikar discloses a method, comprising:

the printer receiving a selection of one of the secured print jobs for printing (col. 12, lines 33-37. Nerlikar can send and retrieve more than one secured document (or a plurality of faxed and retrieved secure documents) since fax machines are designed to send more than one communication (fax, document, image, etc.). Nerlikar merely describes a scenario/example of a single secure communication, but can definitely send more than one secure document. When a user sends more than one secure communication there will indeed be a plurality of prompts, alerts, or indications (col. 12, lines 18-24) on the receiving end that secure documents are waiting for a certain recipient(s). Examples of an indication

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are given at column 12, lines 21-24 and a light or a note appearing on the facsimile machine reads on displaying a list of waiting print jobs because there would be a note or light for each of the waiting document(s). Applicants only show support of displaying a list of waiting print jobs (with some sort of identifier) at page 4, lines 17-20, page 11, lines 21-24 and page 13, lines 7-11, and not displaying the actual secured print job documents. The indicator of Nerlikar reads on the list that indicates that secured jobs are waiting/pending.);

the printer comparing an entered bio signature for a user to the authorized bio signature for the selected print job (col. 12, lines 33-37); and

the printer printing the selected print job if the entered bio signature matches the authorized bio signature for the selected print job (col. 12, lines 33-37).

Does not disclose a printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith.

Olsen et al teaches that the verified user may then view a document list from a printer interface, col. 10, lines 51-54.

Nerlikar and Olsen et al are analogous art because they are from the similar problem solving area of secure document delivery. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the feature of display of pending documents taught by Olsen et al to the receiving printer of Nerlikar in order to obtain a device capable of showing pending documents. The motivation for doing so would be to select documents that the user intends and is allowed to print.

Regarding claim 22, Nerlikar discloses a method of Claim 21, further comprising prompting a user to enter a bio signature of the user at the printer after receiving a selection of one of the secured print jobs for printing (col. 12, lines 33-37).

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Regarding claim 23, Nerlikar discloses a method of Claim 21, wherein the printer printing the selected print job if the entered bio signature matches the authorized bio signature for the selected print job comprises the printer printing the selected print job only if the entered bio signature matches the authorized bio signature for the selected print job (col. 12, lines 33-37).

Regarding claim 26, Nerlikar discloses a method of Claim 21, further comprising tracking usage of the printer according to an entered bio signature (a document sent by secretary A is not allowed to be printed until secretary B initializes printing by validating secretary B's identity with the RFID/biometric security, col. 12, lines 13-37).

2. Claims 27, 28, 31, and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drabble (WO 200062474 A1) in view of well-known prior art.

Regarding claim 27, Drabble disclose a printing system, comprising:

a computer (computer 10, Fig. 1);

a first biometric identification device (fingerprint reader or video camera, page 5, para. 3) operatively connected to the computer (step b, page 2, para. 1) for entering bio signatures directly into the computer;

the computer configured to associate an authorized bio signature entered through the first biometric identification device with a secured print job (step b, page 2, para. 1);

a printer operatively connected to the computer (it is well known that printers are attached to computer devices to print out documents);

a second biometric identification device (fingerprint reader or video camera, page 5, para. 3) operatively connected to the printer (see Fig. 1 and it is well known that printers are attached to computer devices to print out documents. Drabble teaches a receiving computer receiving images (with an attached biometric device (fingerprint reader or video camera, page 3, para. 3) for access to received images. Examiner further states that it is well-known

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that recipients wish to print and/or save received documents/images and a printer and/or a memory are items that well-known to be attached to a processing computer. A printer is also well-known to be a computer/processor device and can accordingly have a biometric reader, such as a camera or fingerprint reader, attached.) for entering bio signatures directly into the printer; and

the printer configured to compare a bio signature of a user entered through the second biometric identification device to an authorized bio signature associated with a secured print job received from the computer, and print the print job if the entered bio signature matches the authorized bio signature (step d, page 2, para. 1 and page 5, para. 3).

Regarding claim 28, Drabble disclose a system of Claim 27, wherein the printer configured to print the print job if the entered bio signature matches the authorized bio signature comprises the printer configured to print the print job only if the entered bio signature matches the authorized bio signature (step d, page 2, para. 1 and page 5, para. 3).

Regarding claim 31, Drabble disclose a system of Claim 27, wherein the printer is further configured to track usage of the printer according to an entered bio signature (verification of a bio-metric reads on tracking usage)

Regarding claim 34, Drabble disclose a system of Claim 27, wherein the printer comprises a fax machine (it was well-known in the art to transfer secure documents using fax machines and further, printers integrated with facsimile capability was well-known in the art).

Regarding claim 35, Drabble disclose a system of Claim 27, wherein the bio signatures comprise an electronic representation of a user's fingerprint (fingerprint reader or video camera, page 5, para. 3).

Claim 36, a method claim, is rejected for the same reasons as claim 27 and Drabble can surely send and retrieve more than one secured document (or a plurality of faxed and retrieved

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secure documents) since fax machines are designed to send more than one communication (i.e., image or email as taught by Drabble). Drabble merely describes a single secure communication, but can definitely send more than one secure image. In addition, Examiner responds that Drabble can surely send an email intended for several recipients or even send the same email to several recipients at different times. When a user sends a secure image/e-mail to several recipients, obviously several bio-signatures are necessary to be securely received by the recipient(s). Also, when a user sends the same secure image/e-mail to several recipients at different times, obviously several bio-signatures are necessary to be securely received by the recipient(s) at their received locations. A user sending a document (image or e-mail as taught by Drabble) to several users can obviously associate the biometric data with more than one user. In addition, a user can send out the document a plurality of times and associate a biometric user to each of the plurality of communications.

Claim 37, a method claim, is rejected for the same reasons as claim 28.

(10) Response to Argument

GROUND NO. 1

Claims 21-23 and 26 stand rejected under Section 103 as being obvious over Nerlikar (5629981) in view of Olsen (6952780).

Nerlikar teaches a fax machine printing a faxed document only when the intended recipient is confirmed by RFID and, optionally, by "biological or voice signature." The pertinent text in Nerlikar is quoted below.

"Once secretary A sends the document, the network does not transmit the secure document to the receiving facsimile machine. Instead, the network will store the document electronically in the buffer of the receiving fax machine or at the network buffer. At this point, the network can send an indication to authorized secretary B or other authorized recipient(s) at this

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location that a secure document is waiting to be retrieved. This indication can come in the form of a light appearing on the fax machine, a flashing light on her telephone, or a note on the computer screen, or a combination of any of the foregoing. This aspect is critical to security because the secure document is not automatically printed when secretary B is not present. At secretary B's convenience, secretary B will go to the fax machine. As secretary B approaches the machine, when proximity to the machine permits, a handshake between secretary B's fax machine reader and secretary B's RFID badge will occur. The fax machine will recognize that secretary B is the authorized recipient and has a secure document ready for receipt. At this point, if secretary B's RFID badge or the system utilizes the additional biological or voice signature security feature, the facsimile machine may ask secretary B to say the name or provide a finger for reading or an eye retina for reading. This additional step guarantees that the person wearing the badge is in fact secretary B. After identification is verified, the fax may once again revalidate with the network server the authorization of secretary B to receive the fax and the fax is printed and all transaction details and records are updated automatically."

Nerlikar column 12, lines 13-42.

"Olsen is merely relied upon for displaying the pending print jobs for a user to view."

Supplemental Action (mailed March 12, 2007) page 2.

Claim 21 recites "the printer displaying a plurality of pending secured print jobs each having an authorized bio signature associated therewith." *Nerlikar describes only a single document faxed from secretary A to secretary B -- there is no plurality of pending print jobs in Nerlikar. And, there is no suggestion in Nerlikar that even this single document is displayed anywhere as a pending print job, specifically not on the fax machine. Olsen teaches displaying a list of print jobs on a display 126 that is not part of the printer 116. Olsen column 10, lines 36-62*

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and Fig. 2. So, Olsen also does not teach the printer displaying a plurality of pending print jobs (secured or otherwise).

Examiner responds that Nerlikar can surely send and retrieve more than one secured document (or a plurality of faxed and retrieved secure documents) since fax machines are designed to send more than one communication (fax, document, image, etc.). Nerlikar merely describes a scenario/example of a single secure communication, but can definitely send more than one secure document. When a user sends more than one secure communication there will indeed be a plurality of prompts, alerts, or indications (col. 12, lines 18-24) on the receiving end that secure documents are waiting for a certain recipient(s). Examples of an indication are given at column 12, lines 21-24 and a light or a note appearing on the facsimile machine reads on displaying a list of waiting print jobs because there would be a note or light for each of the waiting document(s). Applicants only show support of displaying a list of waiting print jobs (with some sort of identifier) at page 4, lines 17-20, page 11, lines 21-24 and page 13, lines 7-11, and not displaying the actual secured print job documents. The indicator of Nerlikar reads on the list that indicates that secured jobs are waiting/pending.

Furthermore, in Olsen the only print jobs that are displayed are those that the "verified" user is authorized to print. That is to say, the act of verifying that the user is authorized to print a print job has already been completed as a prerequisite to the act of displaying the print job(s). In the method of Claim 21, by contrast, the act of comparing bio signatures is not a prerequisite to the act of displaying the print jobs. In fact, the act of comparing bio signatures in Claim 21 is performed after the act of displaying the print jobs. Thus, even if the Examiner were to find a reference that teaches an Olsen type display at a printer, adding such a post-verification display to Nerlikar still does not yield all of the limitations in the method of Claim 21.

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Examiner responds that this prerequisite validation prior to displaying documents is simply not the case with Olsen. The user is allowed to select a print job from those that are displayed but cannot print or perform an operation on the print job until the user gets proper verification, which is clearly taught at column 6, lines 14-20 of Olsen et al. Once the user is validated, then the user may be granted access to the spooled document in the document list, see column 6, lines 21-25.

This distinction is significant. The method of Claim 21 allows for the printer displaying secured print jobs that are not all associated with the same bio signature. Olsen does not and Nerlikar does not. There is no utility in having a user step up to Nerlikar's fax machine, enter her bio signature to bring up a display of print jobs she is authorized to print as in Olsen, and then, when she has selected from the list, to have her again enter her bio signature as a prerequisite to print what is already known to be an authorized print job. The apparent purpose of Olsen's verification of the list of print jobs is to eliminate the need for a subsequent verification of any individual print job selected from the list. There is just no reason a person skilled in the art would use the display of Olsen in the fax printing procedure of Nerlikar without eliminating either the "pre-listing" verification of Olsen or the "post-selection" verification of Nerlikar.

Examiner responds that this alleged "pre-listing" verification is simply not the case with Olsen. The user is allowed to select a print job from those that are displayed but cannot print or perform an operation on the print job until the user gets proper verification, which is clearly taught at column 6, lines 14-20 of Olsen et al. Once the user is validated, then the user may be granted access to the spooled document in the document list, see column 6, lines 21-25. The listing in Olsen is presented to the user but the user is only allowed to access jobs if the user is subsequently validated upon selection of a certain print job. If a job is shown but the user is not authorized to access the job, the user will not be granted access.

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GROUND NO. 2

Claims 27, 28, 31 and 34-37 stand rejected under Section 103 as being obvious over Drabble WO20062474 in view of well known prior art.

A Second Biometric Device Entering Bio Signatures Directly Into The Printer

Claim 27 was rejected under Section 103 as being obvious over Drabble WO20062474 in view of "well known prior art." Claim 27 recites a second biometric identification device operatively connected to the printer for entering bio signatures *directly* into the printer. Neither of Drabble's video cameras enters bio signatures directly into a printer. And, there is absolutely no suggestion whatsoever in Drabble that his "facial biometric template" could or should be implemented at a printer. Indeed, implementing Drabble's facial imaging and matching method at a printer would negate the ability to display the document on the computer screen, as expressly taught at page 4.

In response, in the Advisory Action, the Examiner states: "Examiner responds that Drabble clearly teaches that 'a receiving computer will also include a connection to a fingerprint reader', see page 3, para. 3. The receiving computer (Drabble) reads on a receiving facsimile, receiving host computer, receiving printer, receiving MFP, etc., since all of these devices are computing devices that are capable of receiving images (receiving images is taught by Drabble, page 3, para. 3, line 4) as is well-known in the art. As is known in the art, a user receiving a document usually wants to print, display, and/or save the document. Although the Examiner may have indicated the camera attached to the computing device (i.e., printer), [sic]"

Even if it is assumed (for purposes of argument only) that the printer recited in Claim 27 is a computing device, it does not follow therefrom that Drabble's receiving computer is a printer. There is not the least suggestion in Drabble that his receiving computer has any printing

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function whatsoever. The printer recited in Claim 27 does not read on Drabble's receiving computer. It necessarily follows, therefore, that any biometric identification device connected to the Drabble receiving computer does not anticipate or make obvious "a second biometric identification device operatively connected to the printer for entering bio signatures directly into the printer" as recited in Claim 27.

Examiner responds that Applicants are claiming a printer system with a computer, a first and second biometric device, and a printer. Examiner has stated that even though the system of Drabble doesn't explicitly state a printing device, the receiving computer that receives an image is synonymous with a facsimile machine that receives images and that fax machines print received images as is well known in the art of transmitting/receiving images. Drabble teaches a receiving computer receiving images (with an attached biometric device (fingerprint reader or video camera, page 3, para. 3) for access to received images. Examiner further states that it is well-known that recipients wish to print and/or save received documents/images and a printer and/or a memory are items that well-known to be attached to a processing computer. A printer is also well-known to be a computer/processor device and can accordingly have a biometric reader, such as a camera or fingerprint reader, attached. In view of the guidance provided by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, Examiner is combining prior art elements according to known methods to yield the predictable results of secure printing of a document. It is also "obvious to try" since documents received by users are often printed.

Associating a Plurality of Authorized Bio Signatures with a Single Print Job

Claims 36 and 37 were rejected under Section 103 as being obvious over Drabble WO20062474 in view of well known prior art "for the same reasons" as Claims 27 and 28. Method Claim 36, however, is not a counterpart to system Claim 27. Claim 36 recites a

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computer associating a plurality of authorized bio signatures with a single job. The Examiner has made no showing that either Drabble or the so-called "well known prior art" teach this association. In fact, they do not.

In a response, in the Advisory Action, the Examiner states:

"Claims 36 and 37 are substantially similar to claims 27 and 28 the only difference being the grouping of signatures associated with a document. The prior art of Drabble in view of well-known prior art also teaches all of the limitations of Applicant's claimed features of 37 and 38. A user sending a document (print job) to several users can obviously associate the biometric data with more than one user. In addition, a user can send out the document a plurality of times and associate a biometric user to each of the plurality of communications."

Claim 36 recites a computer associating a plurality of authorized bio signatures with a single print job and the printer comparing an entered bio signature for a user to the authorized bio signatures for the print job. The Examiner's response does not address either limitation. Even if it is assumed (for purposes of argument only) that Drabble and/or well-known prior art teaches that a user can "associate the biometric data with more than one user" or that "a user can send out the document a plurality of times and associate a biometric user to each of the plurality of communications", any such teaching has no apparent relevance to a computer associating a plurality of authorized bio signatures with a single print job or a printer comparing an entered bio signature to the authorized bio signatures for the single print job. Hence, the Examiner has still not made out a prima facie case of obviousness as to Claims 36 and 37.

Examiner responds that Drabble can surely send and retrieve more than one secured document (or a plurality of faxed and retrieved secure documents) since fax machines are designed to send more than one communication (i.e., image or email as taught by Drabble). Drabble merely describes a single secure communication, but can definitely send more than

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one secure image. In addition, Examiner responds that Drabble can surely send an email intended for several recipients or even send the same email to several recipients at different times. When a user sends a secure image/e-mail to several recipients, obviously several bio-signatures are necessary to be securely received by the recipient(s). Also, when a user sends the same secure image/e-mail to several recipients at different times, obviously several bio-signatures are necessary to be securely received by the recipient(s) at their received locations. A user sending a document (image or e-mail as taught by Drabble) to several users can obviously associate the biometric data with more than one user. In addition, a user can send out the document a plurality of times and associate a biometric user to each of the plurality of communications.

(11) Related Proceeding(s) Appendix

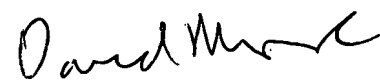
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

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